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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,501	09/19/2003	James L. Chappuis	050313-1120	8957
24504	7590	12/18/2007	EXAMINER	
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 600 GALLERIA PARKWAY, S.E. STE 1500 ATLANTA, GA 30339-5994			HOUSTON, ELIZABETH	
		ART UNIT	PAPER NUMBER	
		3731		
		MAIL DATE	DELIVERY MODE	
		12/18/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/666,501	CHAPPUIS, JAMES L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Elizabeth Houston	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 September 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,5-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- Notice of References Cited (PTO-892)
- Notice of Draftsperson's Patent Drawing Review (PTO-948)
- Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. Claim 1 objected to because of the following informalities: The limitation "said stop portion along said shaft is fixed with respect to said cutting portion" does not depict properly what applicant is intending to claim. The language is interpreted such that the stop portion does not move with respect to or relative to the cutting portion. However, according to the specification and claim 2, the stop position rotates freely, thereby indicating that that stop does in fact move with respect to the cutting portion.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrante et al. (US 5,098,436) in view of Ferrante et al (US 5,415,662).**

5. Ferrante '436 discloses a medical bur for cutting bone (see Fig. 5) comprising a handle; a shaft (63); a bur head (60) having a cutting portion (62), and a stop portion (66) along the shaft. The bearing sleeve (66) acts as a stop in that it will stop the bur when the bearing sleeve reaches the end of the guide channel (22). The cutting portion is located between the handle and the stop portion and exhibits symmetry about its longitudinal axis, which is aligned with the longitudinal axis of the shaft. The stop is located at a terminal end of the shaft and spaced from the cutting portion to permit independent movement of the cutting portion with respect to the stop portion (Col 5, line 24). The stop portion covers the terminal end of the shaft. The cutting portion rotates under power to cut through bone while the stop is *capable* of preventing contact of the cutting portion with soft tissue located adjacent the bone being cut. The proximal edge of the stop portion corresponds to the size and shape of the distal edge of the cutting portion. The bur head is spherical and the stop portion is shaped as a portion of the sphere.

6. Ferrante '436 is silent to the limitations that the stop portion (66) along the shaft is fixed with respect to the cutting portion and the stop portion rotates freely.

7. Ferrante '662 discloses a nearly identical device (Figs. 4 and 5) and explicitly discloses that the stop (66) does not rotate with the cutting element, but rather rotates independently of the cutting element (Col 5, line 23). Thus, Ferrante discloses that the

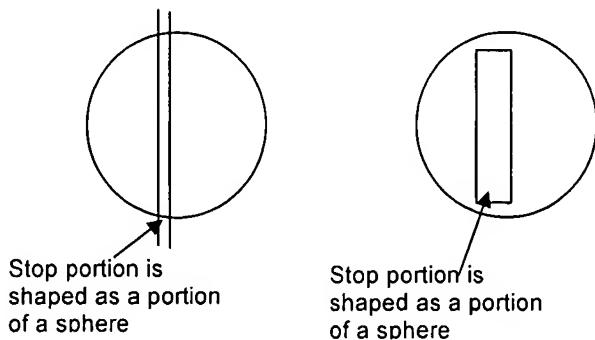
stop portion is fixed with respect to the cutting portion (in the same way that instant invention is) and rotates freely.

8. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the feature of the stops not rotating with respect to the cutting element as taught by Ferrante '662. Since the stops are used to guide the device through the channels (20), it makes sense that one would not want them to rotate with the cutting device thus rotating at the same speed as the cutting device. Having the stops rotate independently of the cutting element allows the user to have better control of the device than if the stops rotated at the high speed of the cutting element.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 09/27/07 with respect to claim 5 have been fully considered but they are not persuasive. Applicant argues that Ferrante does not disclose a stop that is shaped as a portion of a sphere, however examiner respectfully disagrees. The drawing below shows how the cylindrical<sup>shape</sup> can be a "portion" of a sphere.



***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Houston whose telephone number is 571-272-7134. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

eh gat  
12/10/07

  
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SPE  
3731